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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,915	01/17/2001	Yasuo Tano	4084-2163	5564
21888	7590	09/05/2007	EXAMINER	
THOMPSON COBURN, LLP			BUI, VY Q	
ONE US BANK PLAZA			ART UNIT	
SUITE 3500			PAPER NUMBER	
ST LOUIS, MO 63101			3734	
			MAIL DATE	DELIVERY MODE
			09/05/2007	PAPER

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The time period for reply, if any, is set in the attached communication.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
09761915	1/17/2001	TANO ET AL.	4084-2163

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3734	20070829

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Commissioner for Patents

Correction-- Examiner's Answer (Grounds of Rejection)

Claim 26 under 35USC 102(b):

This rejection was set forth in the prior final office action mailed 7/19/2004 and substantially copied as below:

Claim Rejections - 35 USC § 102

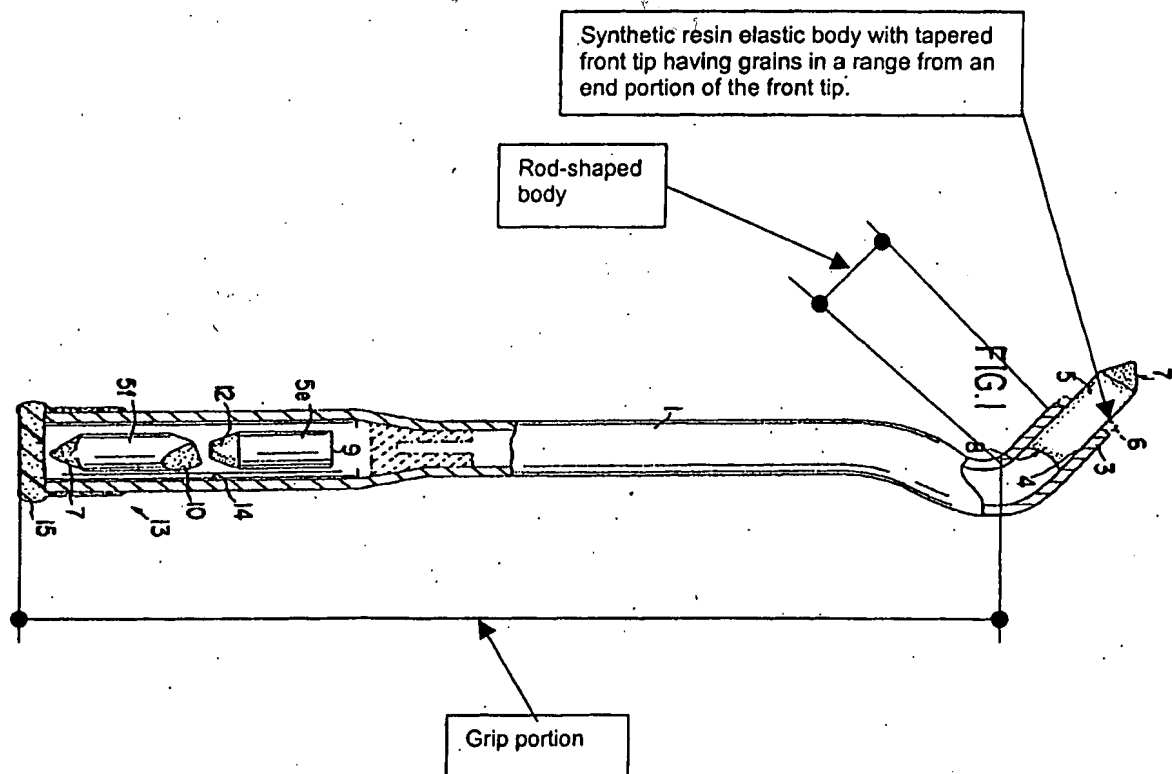
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 26 is rejected under 35 U.S.C. 102(b) as being anticipated by VARAINE (5,118,291).

As to claim 26, VARAINE (see Fig. 1 reproduced on next page; abstract) discloses every structural limitation as recited in the claim.



Claim Rejections - 35 USC § 251


This rejection was set forth in the final office action mailed 7/19/2004 and substantially copied as below:

Present independent claims 1, 9, 12, 21, and 26 and dependent claims 3-4, 7, 10-11, 13-15, 22-25 and 27 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue, which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

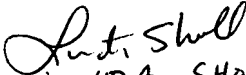
Claim 1 (original application 09/058,183) was amended to recite (I). "a hollow tapered front tip" (see line 7, claim 1 of surrendered U.S. Pat. 5,921,998) and (II). "grains are located in a range of 0.5mm to 3.0mm from an end portion of said front tip" (see lines 8-12, claim 1 of surrendered U.S. Pat. 5,921,998) to overcome the 102(b) rejection entered on 12/04/1998 (application 09/058,183) as being anticipated by SHIMIZU (U. S. Pat. 3,809,101). In the argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998), the applicants argued that SHIMIZU does not disclose the features (I) and (II) above, and therefore, amended claim 1 was clearly defined over SHIMIZU. The amendment and argument was presented to obviate the rejection and was convincing, therefore the amended claim 1 was allowed and issued in U.S. Pat. 5,921,998 with features (I) and (II) in claim 1 (see column 6, lines 8, and 11-12, U.S. Pat. 5,921,998). According to the Applicants' argument filed 04/10/1998 (from line 13, page 5 to line 4, page 6 of attached Amendment A/#6, dated April 10, 1998), features (I) and (II) are considered as surrendered subject matters to overcome the prior art of SHIMIZU rejection. See MPEP 1412.02.

Present independent claims 1, 9, 12, 21 and 26 now do not require the tapered tip or taper of the device to be hollow, nor require the range from 0.3 mm to 3.0mm for the grain to be fixed to the tapered tip or taper of the elastic body. The omission of the feature (I) and/or (II) above in the independent claims 1, 9, 12, 21 and 26 of the current application presents an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

Present dependent claims 3-4, 7, 10-11, 13-15, 22-25 and 27 now do not include both features (I) and (II), therefore are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984).


08/29/2007

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